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In re application of

Shin-Ichi Yamaguchi et al.

Serial No. 10/032,741

Filed: October 22, 2001

For: MANUFACTURING METHOD OF BELT AND MANUFACTURING APPARATUS

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:
: DECISION ON
: PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed March 10, 2004.

On September 6, 2003, a non-final office action was mailed by the examiner, rejecting claims 2 and 4. Applicants responded to this office action with a response filed on December 8, 2003. Independent claim 2 was not amended. A final rejection was then mailed on March 10, 2004. Applicants requested that the finality of the office action be withdrawn in a letter filed on March 29, 2004. An after final amendment was also filed by Applicants on April 26, 2004. An advisory action was mailed by the office on June 8, 2004 in which the examiner refused to withdraw the finality of the March 10, 2004 office action. Applicants filed two additional after final amendments on June 8, 2004 and July 14, 2004.

On June 21, 2004, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the March 10, 2004 office action.

Applicants position for the withdrawal of the finality is that the examiner applied a new ground of rejection in the final office action that was not necessitated by any amendment to the claims.

DECISION

Section 706.07 of the MPEP states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

Furthermore, section 706.07(a) of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

In the non-final office action of September 16, 2003, the examiner rejected claim 2 under 35 USC 103 over Wood. In the rejection, the examiner stated that the instantly claimed limitation requiring forming the lay-up prior to placing the components on the mandrel is well known and obvious. In response to the office action, Applicants disputed this assertion and requested that the examiner supply a reference showing such a teaching. The claim was not amended.

In the final office action, the examiner rejected claim 2 over Wood in view of three different references. The additional references were brought into the rejection in order to support the examiner's position in the first office action that the aforementioned feature was well known.

Petitioner urges that the new grounds of rejection were not necessitated by any amendment to the claims.

Section 2144.03 of the MPEP states in part:

PROCEDURE FOR RELYING ON COMMON KNOWLEDGE OR TAKING OFFICIAL NOTICE

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). In *Ahlert*, the court held that the Board properly took judicial notice that "it is old to adjust intensity of a flame in accordance with the heat requirement." See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took "judicial notice of the fact that tape recorders commonly erase tape automatically when new audio information is recorded on a tape which already has a recording on it"). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *Ahlert*, 424 F.2d at 1092, 165 USPQ at 421.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. (“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The facts constituting the state of the art are normally subject to the possibility of rational disagreement among reasonable men and are not amenable to the taking of such notice.”).

It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 (“[T]he Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”). While the court explained that, “as an administrative tribunal the Board clearly has expertise in the subject matter over which it exercises jurisdiction,” it made clear that such “expertise may provide sufficient support for conclusions [only] as to peripheral issues.” *Id.* at 1385-86, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the Board’s decision, the court stated “common knowledge and common sense” on which the Board relied in rejecting Lee’s application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency’s obligation.... The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.”).

If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 (“[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697

Determine Whether the Next Office Action Should Be Made Final

If the examiner adds a reference in the next Office action after applicant’s rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant’s amendment of the claims, the rejection may not be made final. See MPEP § 706.07(a).

Summary

Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in Ahlert, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based. See Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697; Ahlert, 424 F.2d at 1092, 165 USPQ 421.

In the instant application, the Examiner relies on Official Notice that an art specific procedure is well known. This is beyond the "filling in of the gaps" recited above. Therefore, the non-final office action was incomplete and the references cited in the final office action should have been made of record and applied in the non-final office action. In addition, the introduction of the secondary references in the final office action creates a new ground of rejection and at the least, creates new issues that must be considered. For example, faced with a new combination of references Applicants could argue that such a combination was improper. Because Applicants have not had the chance to argue the new grounds of rejection, no clear issue that is ripe for appeal has been developed.

Accordingly, the petition for withdrawal of finality is **GRANTED**. All amendments after final will be entered and considered by the examiner. A new office action will be prepared in response to these amendments.



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